



Atty Dkt. No.: STAN130  
USSN: 09/716,841

## REMARKS

In view of the following remarks, the Examiner is respectfully requested to withdraw the rejections and allow Claims 16-17, 21-23, 26-28, 31-32, 51-52, 55-57, 60-62 and 65-66, the only claims pending and under examination at this time.

The pending claims have been rejected under 35 U.S.C. § 102 (e) as anticipated by U.S. Patent No. 6,372,712.

In maintaining this rejection, the Examiner requested a new declaration be filed by all three of the named inventors of the present application. The Examiner also requested clarification on how the inventorship could be different between the cited patent and the present application.

In view of the enclosed Declaration by all three of the inventors of the present application, it is believed that this rejection may be withdrawn<sup>1</sup>. In particular, the declaration states, *inter alia*:

In contrast to the composition of matter claims of the U.S. Patent No. 6,372,712 patent, the claims of the above-captioned application are directed to a particular use of bifunctional molecules, i.e., methods of modulating pharmacokinetic properties of a drug. To the extent that this particular application is disclosed in the specification of U.S. Patent No. 6,372,712 (if at all), this particular application was not conceived by either of Gregory Ray or Kurt Vogel.

Inventorship of this application is proper. Further, the '712 patent is not §102(e) prior art to this application, because the '712 patent is not the earlier work of another; it is the work of coinventors of the present application.

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<sup>1</sup> Please note that the signed declaration by inventor Gerald Crabtree is not included in this submission as Dr. Crabtree is currently unavailable. As soon as the declaration is signed by Dr. Crabtree , it will be submitted to the Patent Office.

Finally, the pending claims remain provisionally rejected under the judicially created doctrine of obviousness-type double patenting over Application No. 10/025,936. In view of the enclosed Terminal Disclaimer, this rejection may be withdrawn.

## **CONCLUSION**

In view of the above amendments and remarks, this application is considered to be in good and proper form for allowance and the Examiner is respectfully requested to pass this application to issuance.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-0815.

Respectfully submitted,

BOZICEVIC, FIELD & FRANCIS LLP

By:

  
Bret E. Field  
Registration No. 37,620

Date: June 10, 2004

encs:

Terminal Disclaimer over application serial no. 10/025,936

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Menlo Park, CA 94025  
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Facsimile: (650) 327-3231

**Declaration Under 1.132**

Address to:  
Assistant Commissioner for Patents  
Washington, D.C. 20231

Attorney Docket Confirmation No.	STAN-130
First Named Inventor	Briesewitz
Application Number	09/716,841
Filing Date	November 17, 2000
Group Art Unit	1651
Examiner Name	David Naff
Title	Bifunctional Molecules Having Modulated Pharmacokinetic Properties and Therapies Based Thereon

Dear Sir:

We, Dr. Thomas Wandless, Dr. Roger Briesewitz and Dr. Gerald Crabtree, do hereby declare as follows:

We are co-inventors of the above captioned patent application.

We are also a co-inventor of U.S. Patent No. 6,372,712, along with Gregory Thomas Ray and Kurt Vogel.

We understand that U.S. Patent No. 6,372,712 is being cited by the Patent Office to anticipate the claims of the above captioned application pursuant to 35 U.S.C. § 102(e).

U.S. Patent No. 6,372,712 discloses bifunctional molecules and their use in applications for enhancing one or more of a given drug's affinity, specificity or selectivity for its target.

The claims of U.S. Patent No. 6,372,712 are all directed to the bifunctional compounds disclosed in the patent, and the inventorship of these claims has been determined to be as listed on the face of the U.S. Patent No. 6,372,712.

In contrast to the composition of matter claims of the U.S. Patent No. 6,372,712 patent, the claims of the above-captioned application are directed to a particular use of bifunctional molecules, i.e., methods of modulating pharmacokinetic properties of a drug. To the extent that this particular application is disclosed in the specification of U.S. Patent No. 6,372,712 (if at all), this particular application was not conceived by either of Gregory Ray or Kurt Vogel.

Accordingly, we hereby declare that we are the sole inventors of the subject matter disclosed in the cited patent and relied on in the above-summarized rejection.

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We hereby declare that all statements made herein of our own knowledge are true; and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Respectfully submitted,

Date: \_\_\_\_\_

By \_\_\_\_\_  
Thomas Wandless, Ph.D.

Date: 5/24/04

By Roger Briesewitz  
Roger Briesewitz, Ph.D.

Date: \_\_\_\_\_

By \_\_\_\_\_  
Gerald Crabtree, Ph.D.

**Declaration Under 1.132**

Address to:  
Assistant Commissioner for Patents  
Washington, D.C. 20231

Attorney Docket Confirmation No.	STAN-130
First Named Inventor	Briesewitz
Application Number	09/716,841
Filing Date	November 17, 2000
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Examiner Name	David Naff
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We are co-inventors of the above captioned patent application.

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The claims of U.S. Patent No. 6,372,712 are all directed to the bifunctional compounds disclosed in the patent, and the inventorship of these claims has been determined to be as listed on the face of the U.S. Patent No. 6,372,712.

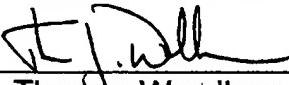
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Date: 20 MAY 2004

Respectfully submitted,  
By   
Thomas Wandless, Ph.D.

Date: \_\_\_\_\_

By \_\_\_\_\_  
Roger Briesewitz, Ph.D.

Date: \_\_\_\_\_

By \_\_\_\_\_  
Gerald Crabtree, Ph.D.